

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No: 09/776,057) Attorney
) Docket Number: 10002445-1
Filed: February 2, 2001)
) Confirmation No.: 9354
Inventor: Robert Sese)
) Group Art Unit: 2625
Title: Method and System for Secured)
 Printing of Documents using) Examiner: Thomas Lett
 Biometric Identification)
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APPEAL BRIEF

1. REAL PARTY IN INTEREST.

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holding, LLC.

2. RELATED APPEALS AND INTERFERENCES.

There are no other appeals or interferences known to Appellant, Appellant's legal representative or the Assignee which will affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

3. STATUS OF CLAIMS.

Claims 21-23, 26-28, 31 and 34-37 are pending. Claims 1-20, 24-25, 29-30 and 32-33 have been canceled. The rejections of all pending claims are appealed.

4. STATUS OF AMENDMENTS.

No amendments were filed after the final action.

5. SUMMARY OF CLAIMED SUBJECT MATTER.

In the method of Claim 21, a printer displays a plurality of pending secured print jobs. An authorized bio signature is associated with each print job. After receiving a selection of one of the secured print jobs, the printer compares an entered bio signature with the authorized bio signature for the selected print job. If the entered bio signature matches the authorized bio signature, then the printer prints the selected print job. One embodiment of the method of Claim 21 is illustrated in Fig. 4 and described in the Specification at page 12, line 21 through page 13, line 20.

In the printing system of Claim 27, two biometric identification devices are used to print a secured print job. A first biometric identification device is connected to the computer for entering bio signatures directly into the computer. A second biometric identification device is connected to the printer for entering bio signatures directly into the printer. Fig. 1 shows a first biometric identification device 104 connected to a computer 109 and a second biometric identification device 107 connected to a printer 110. The computer is configured to associate an authorized bio signature entered through the first biometric identification device with a secured print job. A computer thus configured is described in the Specification at page 8, line 26 through page 9, line 5. The printer is configured to compare a bio signature entered through the second biometric identification device to the authorized bio signature associated with the secured print job and, if the bio signatures match, to print the print job. A printer thus configured is described in the Specification at page 9, lines 14-24.

In the method of Claim 36, a plurality of authorized bio signatures are associated with a single print job. The printer compares an entered bio signature to the authorized bio signatures for the print job and, if the entered bio signature matches one of the authorized bio signatures, prints the print job. One embodiment of the method of Claim 36 is described in the Specification with reference to Figs. 3 and 4 at page 12, lines 11-20 (associating plural signatures with a single print job), and page 13, lines 17-20 (comparing bio signatures).

6. GROUNDS OF REJECTION TO BE REVIEWED.

1. Claims 21-23 and 26 stand rejected under Section 103 as being obvious over Nerlikar (5629981) in view of Olsen (6952780).
2. Claims 27, 28, 31 and 34-37 stand rejected under Section 103 as being obvious over Drabble WO20062474 in view of well known prior art.

7. ARGUMENT.

GROUND NO. 1

Claims 21-23 and 26 stand rejected under Section 103 as being obvious over Nerlikar (5629981) in view of Olsen (6952780).

Nerlikar teaches a fax machine printing a faxed document only when the intended recipient is confirmed by RFID and, optionally, by "biological or voice signature." The pertinent text in Nerlikar is quoted below.

"Once secretary A sends the document, the network does not transmit the secure document to the receiving facsimile machine. Instead, the network will store the document electronically in the buffer of the receiving fax machine or at the network buffer. At this point, the network can send an indication to authorized secretary B or other authorized recipient(s) at this location that a secure document is waiting to be retrieved. This indication can come in the form of a light appearing on the fax machine, a flashing light on her telephone, or a note on the computer screen, or a combination of any of the foregoing. This aspect is critical to security because the secure document is not automatically printed when secretary B is not present. At secretary B's convenience, secretary B will go to the fax machine. As secretary B approaches the machine, when proximity to the machine permits, a handshake between secretary B's fax machine reader and secretary B's RFID badge will occur. The fax machine will recognize that secretary B is the authorized recipient and has a secure document ready for receipt. At this point, if secretary B's RFID badge or the system utilizes the additional biological or voice signature security feature, the facsimile machine may ask secretary B to say the name or provide a finger for reading or an eye retina for reading. This additional step guarantees that the person wearing the badge is in fact secretary B. After identification is verified, the fax may once again revalidate with the network server the authorization of secretary B to receive the fax and the fax is printed and all transaction details and records are updated automatically." Nerlikar column 12, lines 13-42.

"Olsen is merely relied upon for displaying the pending print jobs for a user to view." Supplemental Action (mailed March 12, 2007) page 2.

Claim 21 recites "the printer displaying a plurality of pending secured print jobs each having an authorized bio signature associated therewith." Nerlikar describes only a single document faxed from secretary A to secretary B -- there is no plurality of pending print jobs in Nerlikar. And, there is no suggestion in Nerlikar that even this single document is displayed anywhere as a pending print job, specifically not on the fax machine. Olsen teaches displaying a list of print jobs on a display 126 that is not part of the printer 116. Olsen column 10, lines 36-62 and Fig. 2. So, Olsen also does not teach the printer displaying a plurality of pending print jobs (secured or otherwise).

Furthermore, in Olsen the only print jobs that are displayed are those that the "verified" user is authorized to print. That is to say, the act of verifying that the user is authorized to print a print job has already been completed as a prerequisite to the act of displaying the print job(s). In the method of Claim 21, by contrast, the act of comparing bio signatures is not a prerequisite to the act of displaying the print jobs. In fact, the act of comparing bio signatures in Claim 21 is performed after the act of displaying the print jobs. Thus, even if the Examiner were to find a reference that teaches an Olsen type display at a printer, adding such a post-verification display to Nerlikar still does not yield all of the limitations in the method of Claim 21.

This distinction is significant. The method of Claim 21 allows for the printer displaying secured print jobs that are not all associated with the same bio signature. Olsen does not and Nerlikar does not. There is no utility in having a user step up to Nerlikar's fax machine, enter her bio signature to bring up a display of print jobs she is authorized to print as in Olsen, and then, when she has selected from the list, to have her again enter her bio signature as a prerequisite to print what is already known to be an authorized print job. The apparent purpose of Olsen's verification of the list of print jobs is to eliminate the need for a subsequent verification of any individual print job selected from the list. There is just no reason a person skilled in the art would use the display of Olsen in the fax printing procedure of Nerlikar without eliminating either the "pre-listing" verification of Olsen or the "post-selection" verification of Nerlikar.

For all of these reasons, Claims 21-23 and 26 distinguish patentably over the combination of Nerlikar and Olsen.

GROUND NO. 2

Claims 27, 28, 31 and 34-37 stand rejected under Section 103 as being obvious over Drabble WO20062474 in view of well known prior art.

A Second Biometric Device Entering Bio Signatures Directly Into The Printer

Claim 27 was rejected under Section 103 as being obvious over Drabble WO20062474 in view of "well known prior art." Claim 27 recites a second biometric identification device operatively connected to the printer for entering bio signatures *directly* into the printer. Neither of Drabble's video cameras enters bio signatures directly into a printer. And, there is absolutely no suggestion whatsoever in Drabble that his "facial biometric template" could or should be implemented at a printer. Indeed, implementing Drabble's facial imaging and matching method at a printer would negate the ability to display the document on the computer screen, as expressly taught at page 4.

In response, in the Advisory Action, the Examiner states:

"Examiner responds that Drabble clearly teaches that 'a receiving computer will also include a connection to a fingerprint reader', see page 3, para. 3. The receiving computer (Drabble) reads on a receiving facsimile, receiving host computer, receiving printer, receiving MFP, etc., since all of these devices are computing devices that are capable of receiving images (receiving images is taught by Drabble, page 3, para. 3 line 4) as is well-known in the art. As is known in the art, a user receiving a document usually wants to print, display, and/or save the document. Although the Examiner may have indicated the camera attached to the computing device (i.e., printer), [sic]"

Even if it is assumed (for purposes of argument only) that the printer recited in Claim 27 is a computing device, it does not follow therefrom that Drabble's receiving computer is a printer. There is not the least suggestion in Drabble that his receiving computer has any printing function whatsoever. The printer recited in Claim 27 does not read on Drabble's receiving computer. It necessarily follows, therefore, that any biometric identification device connected to the Drabble receiving computer does not anticipate or make obvious "a second biometric identification device operatively

connected to the printer for entering bio signatures directly into the printer" as recited in Claim 27.

Associating a Plurality of Authorized Bio Signatures with a Single Print Job

Claims 36 and 37 were rejected under Section 103 as being obvious over Drabble WO20062474 in view of well known prior art "for the same reasons" as Claims 27 and 28. Method Claim 36, however, is not a counterpart to system Claim 27. Claim 36 recites a computer associating a plurality of authorized bio signatures with a single job. The Examiner has made no showing that either Drabble or the so-called "well known prior art" teach this association. In fact, they do not.

In a response, in the Advisory Action, the Examiner states:

"Claims 36 and 37 are substantially similar to claims 27 and 28 the only difference being the grouping of signatures associated with a document. The prior art of Drabble in view of well-known prior art also teaches all of the limitations of Applicant's claimed features of 37 and 38. A user sending a document (print job) to several users can obviously associate the biometric data with more than one user. In addition, a user can send out the document a plurality of times and associate a biometric user to each of the plurality of communications."

Claim 36 recites a computer associating a plurality of authorized bio signatures with a single print job and the printer comparing an entered bio signature for a user to the authorized bio signatures for the print job. The Examiner's response does not address either limitation. Even if it is assumed (for purposes of argument only) that Drabble and/or well-known prior art teaches that a user can "associate the biometric data with more than one user" or that "a user can send out the document a plurality of times and associate a biometric user to each of the plurality of communications", any such teaching has no apparent relevance to a computer associating a plurality of authorized bio signatures with a single print job or a printer comparing an entered bio signature to the authorized bio signatures for the single print job. Hence, the Examiner has still not made out a *prima facie* case of obviousness as to Claims 36 and 37.

Respectfully submitted,

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APPENDIX I -- CLAIMS INVOLVED IN THE APPEAL

1-20.(canceled)

21.(previously presented) A method, comprising:

the printer displaying a plurality of pending secured print jobs each having an authorized bio signature associated therewith;

the printer receiving a selection of one of the secured print jobs for printing;

the printer comparing an entered bio signature for a user to the authorized bio signature for the selected print job; and

the printer printing the selected print job if the entered bio signature matches the authorized bio signature for the selected print job.

22.(previously presented) The method of Claim 21, further comprising prompting a user to enter a bio signature of the user at the printer after receiving a selection of one of the secured print jobs for printing.

23.(previously presented) The method of Claim 21, wherein the printer printing the selected print job if the entered bio signature matches the authorized bio signature for the selected print job comprises the printer printing the selected print job only if the entered bio signature matches the authorized bio signature for the selected print job.

24-25.(canceled)

26.(previously presented) The method of Claim 21, further comprising tracking usage of the printer according to an entered bio signature.

27.(previously presented) A printing system, comprising:

- a computer;
- a first biometric identification device operatively connected to the computer for entering bio signatures directly into the computer;
- the computer configured to associate an authorized bio signature entered through the first biometric identification device with a secured print job;
- a printer operatively connected to the computer;
- a second biometric identification device operatively connected to the printer for entering bio signatures directly into the printer; and
- the printer configured to compare a bio signature of a user entered through the second biometric identification device to an authorized bio signature associated with a secured print job received from the computer and print the print job if the entered bio signature matches the authorized bio signature.

28.(previously presented) The system of Claim 27, wherein the printer configured to print the print job if the entered bio signature matches the authorized bio signature comprises the printer configured to print the print job only if the entered bio signature matches the authorized bio signature.

29-30.(canceled)

31.(previously presented) The system of Claim 27, wherein the printer is further configured to track usage of the printer according to an entered bio signature.

32-33.(canceled)

34.(previously presented) The system of Claim 27, wherein the printer comprises a fax machine.

35.(previously presented) The system of Claim 27, wherein the bio signatures comprise an electronic representation of a user's fingerprint.

36.(previously presented) A method, comprising:

 a computer associating a plurality of authorized bio signatures with a single print job;

 the computer sending the print job to a printer;

 the printer comparing an entered bio signature for a user to the authorized bio signatures for the print job; and

 the printer printing the print job if the entered bio signature matches one of the authorized bio signatures.

37.(previously presented) The method of Claim 36, wherein the printer printing the print job if the entered bio signature matches one of the authorized bio signatures comprises the printer printing the print job only if the entered bio signature matches one of the authorized bio signatures.

APPENDIX II -- EVIDENCE SUBMITTED UNDER RULES 130, 131 OR 132

none

APPENDIX III -- RELATED PROCEEDINGS

none